

**REMARKS**

In response to the objection to the Abstract, applicant has amended the Abstract as suggested by the Examiner. Also, claim 2 has been amended as also suggested by the Examiner.

The Examiner has rejected claims 1-3 under 35 USC § 103(a) as being unpatentable over Baxendale in view of Gregory et al. for the reasons set forth therein. Applicant respectfully submit that the Baxendale and Gregory references fail to teach or suggest the claimed invention of forming a first machine-readable indicia in an image layer on a media, and then forming a second machine-readable indicia in a protective layer that is identical in content to, and in register with, the first machine-readable indicia as taught and claimed by Applicant. While Baxendale discloses the use of a relief image in the layer, it does not teach or suggest that there is a second indicia that is identical to and in registration with a first indicia on the image layer as taught and claimed by Applicant. There is no teaching or suggestion in Baxendale of having any relationship between the image in the protective layer with the image on the media as taught and claimed by Applicant. What is taught is the providing of a desired surface pattern as set forth at column 2, lines 1-3. As further described at column 2, lines 20 et al. the relief image of Baxendale is most clearly seen in reflected light from a discrete source. The relief image is used for automatic image authentication. There is no teaching or suggestion of any relationship between the relief image in the outer layer with that on the surface of the media as taught and claimed by Applicant. The Gregory reference is directed to a security coding article where there is provided an i-r mark having superimposed thereover a coded color mark. See column 3, lines 1-5. As set forth in the Gregory et al. reference, the color coded mark is used to hide or disguise the coded i-r mark or rendered indecipherable by visual inspection. Applicant respectfully submit that the Gregory et al. reference fails to teach or suggest the providing of a first machine-readable indicia on a media and a second machine-readable indicia in a protective overlayer that is identical in content to and in registration with the machine-readable indicia. The Gregory reference teaches away from Applicant's invention such as it is trying to hide the media mark below. There is no teaching or suggestion that the images are identical or in registration as specifically taught

and claimed by Applicant. One of the advantages of the present invention is by providing a machine readable code that provides enhanced machine-readable code as the code on the media and the code on the protective layer react together to provide improved reading of the code.

As set forth in MPEP 706.02(j)


"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - §2143.03 for decisions pertinent to each of these criteria.

"The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. 'To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections."

It is clear that the burden is on the Examiner to provide some suggestion of the desirability to do what the Applicant has done. In addition, the Examiner must show how the prior art teaches each and every element of the claimed invention. In the Baxendale reference, they are providing a particular surface having a particular type relief image on the medium, wherein the Gregory et al. reference is directed to providing a security code having a coded i-r mark and a coded color mark when the coded color mark is disposed over the coded i-r mark to hide the image. There would be no motivation or reason to combine the two references as hiding of the image is undesirable in the Baxendale reference. Furthermore, neither of the two cited references teach the claimed element of providing a first machine-readable indicia in an image layer on a media and a second machine-readable indicia in a protective layer that is identical to and in content to and in registration with the first machine-readable indicia.

Accordingly, it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.